

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

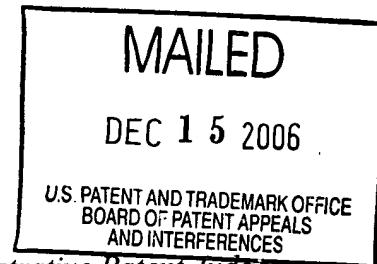
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG A. FINSETH, JEFFREY A. BROWN, and PHILIP E. HSIAO

Appeal No. 2006-3229
Application No. 09/536,101

ON BRIEF



Before JERRY SMITH, DIXON, and SAADAT, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the Examiner's final rejection of claims 1-6, 8-14, 16-24, 26-34, and 36-62, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and apparatus for watermarking received television content. An understanding of the invention can be derived from a reading of exemplary claims 1 and 19, which are reproduced below.

1. A television system comprising:

a receiver for receiving broadcast television content comprising multiple frames of data;

means for inserting multiple copies of a receiver identification representing a frame of the television content, and

means for generating a display of television images based upon the data representing the television content and the receiver identification data.

19. A program reception system comprising:

receiver for receiving transmitted data representing program content comprising multiple frames;

means for modifying a frame of the data representing the program content to include multiple copies of receiver identification; and

means for providing the modified data representing the program content to a presentation device.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Ito	2001/0013097	Aug. 9, 2001
Kimura	6,674,858	Jan. 6, 2004
Narayanaswami	2003/0011684	Jan. 16, 2003
Kaiser	6,615,408	Sep. 2, 2003
Hogan	6,137,952	Oct. 24, 2000
Klosterman	2001/0013124	Aug. 9, 2001

REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we make reference to the Examiner's answer (mailed Apr. 19, 2006) for the reasoning in support of the rejection, and to Appellants' brief (filed Jan. 31, 2006) and Reply brief (filed Jun. 13, 2006) for the arguments thereagainst.

Claims 19, 20, and 57-59 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ito. Claims 1, 2, 9-10, 17-18, 27-30, 37-40, 44-56, and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Kimura. Claims 3-4, 11-12, 31-32, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Kimura and Narayanaswami. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Narayanaswami. Claims 5, 13, 33, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Kimura, Narayanaswami, and Kaiser. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Narayanaswami and Kaiser. Claim 6, 14, 24, and 34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Kimura and Hogan. Claims 8, 16, 26, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in further view of Kimura and Klosterman.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject

matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. See Studiengesellschaft Kohle v. Dart Indus., Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

We must point out, however, that anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. V. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Appellants argue that none of the Examiner's arguments support that "Ito discloses including multiple copies of receiver ID data in a single frame. Ito's ID may be imprinted across multiple pixels, but that is NOT the same thing as multiple IDs in a single frame" (Br. 13). Appellants argue that the Examiner has relied upon hindsight to reconstruct Appellants claimed invention (Br. 13). We cannot agree with Appellants with respect to hindsight since we do not find that it plays a part in a rejection under anticipation.

From our review of the teachings of Ito, we find that Figures 13-16 teach how an "example of a 3x3 pixel area" is evaluated for content and imprinted with ID information.

We find no express teaching that this 3x3 evaluation and imprinting is done iteratively for the totality of the frame. While we could speculate as to how smaller ID information may be used repeatedly for small areas over the total frame, we do not find any support for such speculation in the express or implied teachings of Ito. Furthermore, the examiner rejected independent claim 19 under 35 USC § 102. Here, we make no findings with respect to obviousness, and find that Ito does not teach “modifying a frame of the data representing the program content to include multiple copies of receiver identification” as recited in independent claim 19. Therefore, we cannot sustain the rejection of independent claim 19 and dependent claims 20 and 57-59.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior

art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, and 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” In re Dembicak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” Dembicak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. Appellants argue that paragraph [0047] would have suggested to one skilled in the art to spread the ID

information over multiple frames rather than use multiple copies in a single frame (Br. 14). The examiner further relies upon paragraphs [0044]-[0055] to support the position that ID information “can be” attached to groups of pixels (Answer 5). The Examiner maintains that Ito teaches inserting the ID data into groups of pixels (i.e. 3x3 groups of pixels)” and therefore multiple copies of the ID information are inserted into a single frame. The Examiner merely relies upon the teachings of Kimura to teach and suggest the use of ID information in broadcast television. While we agree with the Examiner’s combination, we do not find that the Examiner has shown a clear teaching or suggestion in either reference as to using multiple copies of the ID information in a (television) frame as discussed above with respect to independent claim 19. Therefore, we find that the Examiner has not shown that all of the limitations of independent claim 1 are taught or fairly suggested in the prior art applied by the Examiner. Therefore, we cannot sustain the rejection of independent claim 1 and dependent claims 2, 45, 46, and 47.

Similarly, we find that the Examiner has not established a *prima facie* case of obviousness over the combination of Ito and Kimura of independent claims 9, 17, 18, 27, 37, and 44 and their respective dependent claims.

Additionally, the Examiner has relied upon the teachings of Narayanaswami, Kaiser, Hogan, and Klosterman, but has not identified any teaching or suggestion which remedy the deficiency in the combination of Ito and Kimura. Therefore, we cannot find that the Examiner has set forth a *prima facie* case of obviousness, and we cannot sustain the rejections of dependent claims 3-6, 11-14, 16, 21-23, 26, 31-34, 36, and 41-43.

CONCLUSION

To summarize, we have not sustained the rejections of claims 1-6, 8-14, 16-24, 26-34, and 36-62 under 35 U.S.C. §§ 102 and 103.

REVERSED



JERRY SMITH
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge



MAHSHID D. SAADAT
Administrative Patent Judge

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